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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,950	09/26/2001	Gavriel Meron	P-3571-US	9876

27130 7590 01/26/2005

EITAN, PEARL, LATZER & COHEN ZEDEK LLP  
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NEW YORK, NY 10020

EXAMINER
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NASSER, ROBERT L

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/963,950

Applicant(s)

MERON ET AL.

Examiner

Robert L. Nasser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 41-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-15, 17-19, 21, 23-28, 31-37, 39, 40, 47, 48, 50, 51, 53-58, 60, 63-65, 67 and 68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims pending in the application are 1-7,10 -15,17-19,21,23-28,31-37,39-43,50,51,53-58,60,63-65,67 and 68.

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Claims 41-46 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim 28 is objected to in that it is unclear whether the sensing device listed in claim 28 is intended to refer to the same element as the in vivo sensor. Based on prosecution history and the specification, it seems to the examiner that the in vivo sensor and the sensing device are intended to be two distinct elements, and claim 28 will be treated as such.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23, 24, 26, and 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Mullick et al 2003/0167000. The examiner notes that as discussed during the interview of 6/8/2004, applicant cannot limit the definition of a term after the application is filed. As such, the term “configured to be immobilized” is being interpreted to mean capable of being immobilized. Mullick shows a capsule device with an optical dome or sphere 72, and an imaging device located inside the capsule. The capsule also includes a processor (see paragraph 59, line 5). The device further includes a

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battery 54. Claims 32 and 33 are rejected in that the device has a wireless transmitter 18 or 50. With respect to claim 34, the device is capable of being sewn into tissue.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-6, 11-15, 17-19, 21, 35-37, 39, 40, 47, 48, 50, 51, 53-58, 60, and 63-65 are rejected under 35 U.S.C. 103(a) as being obvious over by Mullick et al in view of Swain et al WO 98/11816. As discussed above, Mullick shows a swallowable capsule including an optical dome or sphere 72, an imaging sensor, a battery 22 or 54, and a wireless transmitter 188 or 50, for transmitting the data to an external receiver. The examiner notes that the capsule of Mullick takes images of the digestive tract as it moves through the system. Swain et al shows a device for the identical purpose as Marshall which teaches that in some applications it is also desirable to provide a loop to allow the device to be sewn in place and immobilized for monitoring. Hence, it would have been obvious to modify Mullick et al to use such a loop and immobilization technique, as it is merely the substitution of one known equivalent monitoring technique for another. With respect to claims 14, 15, 36, and 37, the combination does not have the same structure recited in these claims. The examiner notes that the exact structure for engaging the sutures does not solve a stated purpose and is not for a specific reason. As such, the exact structure would have been a mere matter of obvious design choice for one skilled in the art. With respect to claims 60, 63-65, the examiner notes

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that the step of immobilizing the device is surgery and hence the monitoring occurs after surgery. Alternatively, Mullick is used during biopsy procedures.

Claims 3 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullick et al in view of Swain, as applied to claims 1,2, 4-6, 11-15, 17-19, 21, 35-37, 39, 40, 47, 48, 50, 51, 53-58, 60, and 63-65 above, further in view of in view of Sohrab. Sohrab 6549796 shows an analyte-monitoring device that varies the frequency of measurement based on the analyte levels measured, to avoid unnecessary measurements. . Hence, it would have been obvious to modify Marshall et al to vary to measurement frequency based on the measured data (i.e. there would be a controller that controls the measurement), to use the device as efficiently as possible.

Claims 7 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullick et al in view of Swain, as applied to claims 1,2, 4-6, 11-15, 17-19, 21, 35-37, 39, 40, 47, 48, 50, 51, 53-58, 60, and 63-65 above, further in view of in view of Mori 3888237. Mori further teaches that when imaging the gastrointestinal tract, it is also desirable to include a pH sensor to make pH measurements. Hence, it would have been obvious to modify the above combination to make pH measurements, t provide a more complete picture of the patient's condition.

Claims 10 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullick et al in view of Swain, as applied to claims 1,2, 4, 11-15, 17-19, 21, 35-37, 39, 40, 47, 48, 50, 51, 53-58, 60, and 63-65 above, further in view of in view of Mori 3888237 and Fiddian-Green 6010453. Fiddian-Green shows a pH sensor whose optical characteristic change in response to pH. It would have been obvious to modify

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the above combination to use such a sensor, as it is merely the substitution of one known pH sensor for another. Hence, the imaging device would include the pH sensor.

Claims 67, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullick et al in view of Swain, as applied to claims 1,2, 4-6, 11-15, 17-19, 21, 35-37, 39, 40, 47, 48, 50, 51, 53-58, 60, and 63-65 above, further in view of Iddan et al 5604531. Iddan et al further teaches the use of an externally rechargeable battery in the implantable device, such as that of Mullick to extend the useable life of the device. Hence, it would have been obvious to modify use an externally chargeable battery in Mullick, to extend its useable life.

Applicant's arguments filed 11/4/2004 have been considered, but are deemed moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

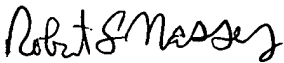
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser  
Primary Examiner  
Art Unit 3736

RLN  
January 24, 2005

  
ROBERT L. NASSER  
PRIMARY EXAMINER